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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/324,182	06/02/99	SHAH	A 2870/155

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HM12/1002

EXAMINER

PULLIAM, A

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

10/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/324,182

Applicant(s)

SHAH ET AL.

Examiner

Amy E Pulliam

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

Receipt is acknowledged of the Declaration and Surcharge, and the Information Disclosure Statement, received August 14, 2000, and June 2, 1999, respectively.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-19, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,523,091 to Pastour *et al.* (hereinafter Pastour).

Pastour discloses a cosmetic emulsion composition which comprises a silicone, a gelling agent, and an emulsifying agent (abstract). Pastour teaches that the emulsifying agent can be dimethicones and mixtures thereof (c 1, l 45). Pastour further teaches that the silicone can be a cyclomethicone (c 3, l 18). Pastour also allows for additives such as vegetable oils such as jojoba oil, apricot oil, grape seed oil, and others (c 5, l 1-13), and he also includes surfactants (c 5, l 20), and pigments (c 5, l 44). Pastour also teaches that the composition can comprise active ingredients such as plant extracts, and these can be present from between 1 and 15%. Further, the cosmetic can contain fillers of plants, either inorganic or synthetic, such as starch or nylon (c 6, l 3-11). Lastly, Pastour teaches that his composition can be in the form of a mascara.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, and 7-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,523,091 to Pastour *et al.*. Pastour is discussed above as disclosing a cosmetic composition, which can be a mascara, and which can contain actives such as plant extracts. Pastour does not teach the specific percent of extract as claimed in claim 3. However, he does teach a very small and similar amount of extract. Further, Pastour does not teach the specific natural non-plant fiber as claimed by applicant. However, he does teach the inclusion of inorganic and synthetic fillers in general. Lastly, Pastour does not teach the specific surfactant as claimed by applicant. It is the position of the examiner that the exact percent of the extract, the specific inorganic additives, and the specific surfactant are all limitations which would be routinely determined by one of ordinary skill in the art, as being suitable, based on the generic teachings in Pastour. One of ordinary skill in the art would have been motivated to make a mascara composition based on Pastour's teachings, which comprises plant extracts, and also contains inorganic or synthetic fillers and surfactants. The expected result would be a successful mascara composition, which has the beneficial qualities of Pastour's composition, which are ease of application, softness, uniformity, hold, and

good sensory qualities. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

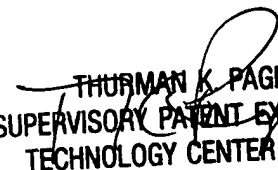
Claims 1, 4, 5, 6, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pastour as applied to claims 1-3, 7-22, 24, and 25 above, and further in view of EP 781 544 to Tanabe *et al.* (hereinafter Tanabe). Pastour does not teach that the plant extract is specifically a fruit extract. Tanabe is relied upon for the teaching that fruit extracts are known in cosmetic, and specifically mascara compositions. Tanabe teaches a cosmetic composition, which can be a mascara, which comprises fruit extracts, such as apple, pear, and peach (p 4, l 3-19). One of ordinary skill in the art would have been motivated to use a fruit extract in Pastour's mascara composition, based on the teachings of Tanabe. Pastour teaches that plant extracts in general can be a component in his composition, but he gives no specific examples. Tanabe specifically teaches that fruits, such as apples, can be used in mascara compositions. One of ordinary skill in the art would expect a mascara composition with the same beneficial qualities claimed by Pastour. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is (703) 308-4710. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7922 for regular communications and (703) 308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Amy E. Pulliam  
Patent Examiner  
Art Unit 1615  
September 27, 2000

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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